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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,240	02/20/2001	Matthew Thomas Hart	550-215	4408

7590 06/14/2004

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EXAMINER

CARDONE, JASON D

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/785,240	Applicant(s) HART, MATTHEW THOMAS	
	Examiner Jason D Cardone	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Attached Office Action</u> . |

DETAILED ACTION

1. Claim 25 is objected to because of the following informalities:

It is suggested that "downloaderc" and "reporterc" should be "downloader" and "reporter". Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick et al. ("McCormick"), USPN 6,421,709, in view of Horvitz et al. ("Horvitz"), USPN 6,161,130.

4. Regarding claim 25, McCormick discloses an apparatus for processing received e-mail messages, the apparatus comprising:

filter data specifying a plurality of tests that may be used to identify unwanted e-mail messages [McCormick, col. 4, lines 18-46];

an e-mail filter operable to receive an e-mail message and to apply the plurality of tests to identify unwanted e-mail messages [McCormick, col. 3, lines 9-12 and col. 8, line 66 – col. 9, line 28]; and

an unwanted message reporter operable to allow reporting to a filter data generator a new unwanted e-mail message received and not identified by the plurality of

tests such that the filter data may be updated to identify the new unwanted e-mail message [McCormick, col. 8, lines 48-65 and col. 9, lines 29-65].

McCormick discloses downloading filters to a client or a centralized e-mail system. McCormick does not specifically disclose a filter downloader operable to download filter data from a remote source. However, Horvitz, in the same email-messaging endeavor, discloses downloading files, from a remote server, to updating filter software. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate downloading of new filters, disclosed by Horvitz, into the email-filtering system, disclosed by McCormick, in order to update the filters.

5. Regarding claim 26, McCormick-Horvitz further discloses the e-mail filter uses a scoring algorithm to identify a received e-mail message as a potentially unwanted e-mail message [McCormick, col. 4, lines 1-46].

6. Regarding claim 27, McCormick-Horvitz further discloses the scoring algorithm is responsive to identification of predetermined words within the received e-mail message and a message size of the received e-mail message [McCormick, col. 4, lines 18-65].

7. Regarding claim 28, McCormick-Horvitz further discloses the scoring algorithm is responsive to an addressee list of the received e-mail message [McCormick, col. 4, line 18 – col. 5, line 9].

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8. Regarding claim 29, McCormick-Horvitz further discloses a received e-mail message identified as a potentially unwanted e-mail message is forwarded to its addressee together with a prompt for the addressee to provide feedback as to whether or not the received e-mail message is an unwanted e-mail message [McCormick, col. 5, line 10 – col. 6, line 28].

9. Regarding claim 30, McCormick-Horvitz further discloses the potentially unwanted e-mail message is forwarded encapsulated within a markup language document providing voting buttons to allow the addressee to provide the feedback [McCormick, col. 5, line 10 – col. 6, line 28 and col. 8, lines 48-65].

10. Regarding claim 31, McCormick-Horvitz further discloses a test creator operable to allow creating of a new test to be added to the tests provided by the filter data [McCormick, col. 9, lines 29-65].

11. Regarding claim 32, McCormick-Horvitz further discloses the apparatus is arranged to receive and process e-mail messages before they reach associated target e-mail sever [ie. Mail Server before the Mail Drop Service, McCormick, col. 10, lines 23-43].

12. Regarding claims 1-24 and 33-36, claims 1-24 and 33-36 have similar limitations as the method disclosed in claims 25-32. Therefore, they are rejected under

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McCormick-Horvitz for the same reasons set forth in the rejection of claims 25-32

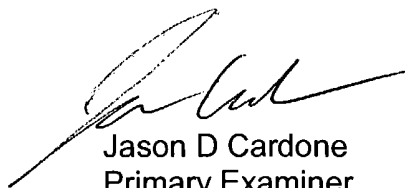
[Supra 25-32].

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D Cardone whose telephone number is (703) 305-8484. The examiner can normally be reached on Mon.-Thu. (9AM-6PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jason D Cardone
Primary Examiner
Art Unit 2142

June 10, 2004